

combination with surface active agents. These teachings do not render obvious the presently claimed invention notwithstanding the unexpected results set forth in the examples in the specification specifically pages 11 and 13 of the present specification which teaches water removal in excess of 91 percent and as high as 95 percent.

Claim 1 is representative of the '672 patent:

1. A non-aqueous liquid composition for displacing liquid films from solid surfaces which consists essentially of
  - a. a fluorinated polyether having the formula  $\text{CF}_3\text{CF}_2\text{CF}_2[\text{OCF}(\text{CF}_3)\text{CF}_2]_n\text{OCHF}\text{CF}_3$ , where n is an integer from 1 to 8 and said fluorinated polyether is present in an amount from 1 to 100 percent by volume;
  - b. from 0 to 99 percent by volume of a solvent selected from the group consisting of volatile liquid perfluoroalkanes, volatile liquid fully fluorinated bromo- and chloro-alkanes, and fully substituted benzenes; and
  - c. from 0 to 1 percent by weight of a solute selected from the group consisting of fluoroalcohols, fluoromonocarboxylic acids, partially fluorinated diesters.

The patented invention is directed to a composition for displacing liquid films from solid surfaces which "consists essentially of" a fluorinated polyether having a specific formula and from 0 to 99 percent of a solvent which can be a perfluoroalkane and from 0 to 1 percent by weight of solute which can be a fluoroalcohol. A variety of fluoroalcohols are recited in a plethora of general formulas set forth in claim 3 of the patent. The Office Action selects the second of a dozen general formulas each having a variety of permutations. See column 3, lines 10 to 34 of the patent and one of the

permutations of the general formula recites tridecafluorooctanol set forth in applicants

claim 5.

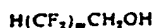
3. A composition as defined by claim 1 wherein said solute is selected from the group consisting of fluoroalcohols having the formula:



wherein m is an integer from 1 to 11, and R is a member of the group consisting of hydrogen and perfluoroalkyl radicals having from 1 to 11 carbon atoms,



wherein m is an integer from 1 to 10 and n is an integer from 1 to 15,



wherein m is an integer from 2 to 10,



and



wherein m is an integer from 2 to 8, fluoromonocarboxylic acids of the formulae:



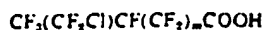
wherein m is an integer from 1 to 10 and n is an integer from 2 to 16,



wherein m is an integer from 1 to 13,



and



wherein m is an integer from 1 to 11, and



wherein m is an integer from 1 to 14, partially fluorinated diesters of the formulae:



wherein  $R_1$  is a member of the group consisting of hydrogen,  $C_1$  to  $C_{12}$  straight chain alkyl,  $C_2$  to  $C_{12}$  straight chain alkenyl and phenyl radicals and m is an integer from 5 to 11, and



wherein  $R_1$  and x have the values as above and m is an integer from 4 to 10.

Notwithstanding, this is not the applicant's invention. Applicants specifically recite at least one surface active agent in combination with a mixture of at least one fluorinated solvent and at least one water immiscible polyfluorinated alcohol having the formula recited in claim 1. There is logic for this and this is not the invention taught in the '672 patent. The '672 patent teaches the necessity of a fluorinated polyether having a specific formula and present in an amount from 1 to 100 percent. Applicant does not recite such a polyether. Nor is such a polyether encompassed in the claims. Furthermore, the perfluoroalkanes and fluoro alcohols may be absent because their concentration can be "0 percent". Thus, the patent teaches the necessity of a polyether not encompassed by applicant's claims alone or in combination with either a solvent or a solute or both.

The non preferred as well as the preferred portion of a reference is pertinent for what it teaches to one skilled in the art. In re Minehardt, 157 USPQ 270 (CCPA 1968). Similarly, teachings of a reference which would lead away from the claimed invention as well as those portions which would render aspects thereof obvious are pertinent for what they teach one skilled in the art. It is not within the framework of 35 USC §103 to pick and choose from the relevant prior art only as much as will support a holding of obviousness to the exclusion of other parts necessary to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1965). The issue of patentability must be approached in terms of what would have been obvious to one skilled in the art at the time the invention was made in view of the sum of all the relevant teachings in the art. Further, a generic disclosure of the prior art is not

anticipatory where the reference does not highlight the claimed mixture among the many dozens disclosed or where one skilled in the art would have to chose judicially from a genus of possible combinations. In re Kollman, 201 USPQ 193 (CCPA 1979); In re Sivaramakrishnam, 213 USPQ 441 (CCPA 1982). Here the '672 patent teaches the criticality of a polyether and the optional character of its combination with a solvent and a solute. Further, the fluoroalcohols are recited to have twelve general formulas each of which has integer permutations and variations in carbon atoms. For example, in a formula the fluoronated carbon atoms can vary from 1 to 10 and the nonfluoronated carbon atoms can vary from 2 to 16 which results in a plethora of specific formulas approaching 160 just for one of the formula. Further, the reference fails to teach the surface active agent and to the exclusion of the polyether.

The Examiner relies upon the secondary reference to supply the deficiencies of the primary reference. The secondary reference teaches a composition "consisting of essentially of" a surface active material in at least one halogenated aliphatic solvent. This limited teaching of a two component system which does not utilize an ether would not suggest the inclusion of the subject surface active agent in the combination specifically taught in the secondary reference.

There is usually an element of "obvious to try" in any research endeavor, since research is not undertaken with complete blindness but with some semblance of a chance of success. But "obvious to try" is not a valid test of patentability. Obviousness must be predicated on something more than it would be "obvious to try" the particular class of solvent, or here surface active agent, recited in the claims or the possibility that it will be

considered in the future, having been neglected in the past. A rejection based on an opinion in an Office Action that it would be essentially "obvious to try" the chemical used in the claimed process which imparted novelty to the subject composition does not meet the requirements of 35 USC §103 that this issue of obviousness be based on the claimed subject matter as a whole. There must be a suggestion or teaching that the claimed novel form of the prior art compound could or should be prepared and there must be a reasonable expectation of success. The issue here is whether the subject experimentation is within the teachings of the prior art.

Here the primary reference considered alone or in combination with the secondary reference do not teach a combination or a surface active agent such as that recited in claims 7 and 8 in a mixture of at least one fluoronated solvent and of at least one water immiscible polyfluoronated alcohol wherein the composition does not exhibit a flash point under standard conditions and has physical characteristics similar to those of CFC 113 and HCFC 141b. Neither are such features inherent from the combination of components taught in the references.

As noted above, it is only applicant who has discovered a substitute for the noted fluoronated compounds which also removes water in an amount from 91 to 95 percent. See the tables on pages 11 and 13:

Page 11 table

Example	Solvent	(%)	% of TDFO	SA2 (ppm)	Water removed (%)
3	347 mcf	98	2	500	93
4	C <sub>4</sub> F <sub>9</sub> CH=CH <sub>2</sub>	95	5	1000	92
5	C <sub>4</sub> F <sub>9</sub> CH=CH <sub>2</sub>	99	1	500	95
6	C <sub>4</sub> F <sub>9</sub> CH <sub>2</sub> CH <sub>3</sub>	99	1	500	91
7	C <sub>4</sub> F <sub>9</sub> CH <sub>2</sub> CH <sub>3</sub>	98	2	500	92
8	C <sub>6</sub> F <sub>11</sub> H	98	2	500	91
9	PF 5060	99	1	500	92
10	PF 5052	99	1	500	94
11	43-10 mee	98	2	500	94

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Example	Surface-active agent	Water removed (%)
15	SA4	93
16	SA5	93
17	SA6	93
18	SA7	95

For these reasons, Applicant respectfully submits that the rejection is in error and should be withdrawn.

For all of the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and that Action is earnestly solicited.

No additional fee is required for this Preliminary Amendment. However, the Commissioner is authorized to charge any other valid fee in connection with this filing, or credit any overpayment, to SGR Deposit Account No. 02-4300.

A Petition For Extension Of Time for four months and the requisite fee therefor is filed concurrently herewith.

Respectfully submitted,  
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